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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Shogo Hyakutake

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EXAMINER

LIN, WEN TAI

ART UNIT

PAPER NUMBER

2154

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/840,155

**Applicant(s)**

HYAKUTAKE ET AL.

**Examiner**

Wen-Tai Lin

**Art Unit**

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-27 and 29-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-27 and 29-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. Claims 1-8, 10-27 and 29-41 are presented for examination.
2. The text of those sections of Title 35, USC code not included in this action can be found in the prior Office Action.

### ***Claim Rejections - 35 USC § 102***

3. Claims 1-5, 7-8, 14-15, 18-24, 26-27, 33-34, 37-38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Grasso et al.[U.S. PGPub. 20040254911].
4. Grasso was cited in the previous office action.
5. As to claim 1, Grasso teaches the invention as claimed including: a method of storing document information in an application service provider (ASP) [210, Fig.3] which is connected to a user terminal [130, Fig. 3] through a network, comprising the steps of:
  - inputting said document information into said user terminal [e.g., 122, Fig.3];
  - inputting a previously created e-mail address into said user terminal, said e-mail address being confirmed by said ASP and corresponding to a storage location in a document database of said ASP [e.g., paragraphs 7, 24 and 34; note that the email address obtained from the ASP must have been confirmed at the time of registration] and sending said document information to said

e-mail address via said network so that the ASP can store the document information at said storage location in the document database [e.g., paragraphs 9, 20 and 23].

6. As to claims 2-5, Grasso further teaches that said step of inputting the document information comprises manually inputting said document information into said user terminal, said the step of manually inputting said document information comprises one of scanning and downloading said document information into said user terminal, wherein said document information is stored to a memory in said user terminal [e.g., 110, 122, Fig.3; i.e., user manually inserts document into scanner, followed by automatic scanning of the document into the scanner].

7. As to claims 7-8, Grasso further teaches that said step of inputting an e-mail address into said user terminal comprises typing said e-mail address into an alphanumeric keypad on said user terminal [i.e., by default this is an optional method of sending inputting the e-mail address], wherein said step of sending said document information to said e-mail address comprises sending the document information via the Internet [150, Fig.3]

8. As to claims 14-15, Grasso teaches sending said document information to said e-mail address comprises sending said document information to said e-mail address concurrently with sending said document information to said user contact device via one of a public phone line and the Internet [paragraph 58].

9. As to claims 18-24, 26-27, 33-34, 37-38 and 40, since the features of these claims can also be found in claims 1-5, 7-8 and 14-15, they are rejected for the same reasons set forth in the rejection of claims 1-5, 7-8 and 14-15 above.

***Claim Rejections - 35 USC § 103***

10. Claims 6 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al.(hereafter "Grasso")[U.S. PGPub. 20040254911], as applied to claims 1-5, 7-8, 14-15, 18-24, 26-27, 33-34, 37-38 and 40 above, further in view of official Notice.

11. Grasso was cited in the previous office action.

12. As to claim 6, Grasso does not specifically teach that said step of inputting a previously created e-mail address into said user terminal comprises storing said e-mail address in a memory of said user terminal and associating said stored e-mail address with a quick send key on a keypad of said user terminal and inputting said e-mail address in response to a selection of said quick send key.

However, official Notice is taken that it is well known in the art that when sending email via an Internet Service Provider (ISP), the subscriber's PC is normally provided with a email agent for storing email address book in a local memory and a selected email address can be quickly entered into the "send to" or "copy to" fields by activating a quick send key (which may also be a predefined key on the alphanumeric keypad).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used such a quick send key for sending Grasso's email because the method is known to be convenient and could also prevent typos.

13. As to claim 25, since the features of this claim can also be found in claims 1, 6 and 20, it is rejected for the same reasons set forth in the rejection of claims 1, 6 and 20 above.

14. Claims 10-13, 16-17, 29-32, 35-36, 39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grasso et al.(hereafter "Grasso")[U.S. PGPub. 20040254911], as applied to claims 1-8, 14-15, 18-27, 33-34, 37-38 and 40 above.

15. As to claims 10-13, Grasso teaches the invention substantially as described in claim 1. Grasso does not specifically teach creating a storage folder for storing documents to said ASP.

However, official Notice is taken that storing data in various storage folder created by a user is well known in the art. For example, an Internet Service Provider (ISP) may offer each subscriber certain storage space for storing personal web pages, wherein a file manager is available for creating various subfolders for storing designated document types.

Since Grasso's ASP server needs to handle different subscribers' data and each subscriber may transfer different types of data or image into the server, it is obvious to one of ordinary skill in the art to have used the well known file manager to create different folders for different subscribers, and various subfolders under each subscriber's folder to record different

type of document information, because this is a nominal approach for organizing large volume of data.

Grasso further teaches that users may register with an Internet web site of the knowledge management service provider by registering one or several of their own printers (facsimile machines, scanners or multi-function devices) with the service provider, specifying their network address and preferred print protocol. The Internet knowledge management web site provides the customer with the augmented recording queues corresponding to the registered devices [paragraphs 24].

Grasso does not specifically teach that each different type of data (i.e., data produced from facsimile machines, scanners, etc) is being placed in different folders, each associated with a folder email address and a backup email address for storing the particular type of document.

However, it is well known that storing different types of data in different folders is a well-known practice of organizing stored document. WOB to organize Grasso's document storage with different folders by further associating Grasso's recording queues in a folder of its data type because different data type requires different post processing for retrieving information about the content of the documents, and by sending the data to a different storage folder (via a respective email address and/or backup email address for a respective mirror site) would facilitate the process of archiving the data.

16. As to claims 16-17, 29-32, 35-36, 39 and 41, since the features of these claims can also be found in claims 1-15, 18-24, 26-28, 33-34, 37-38 and 40, they are rejected for the same reasons set forth in the rejection of claims 1-15, 18-24, 26-28, 33-34, 37-38 and 40 above.

17. Applicant's arguments with respect to claims 1-9, 10-27 and 29-41 have been considered but they are not deemed to be persuasive.

Specifically, Applicant argues that Grasso does not teach that the document information is sent to the ASP via email. The cited passage from paragraphs 7 and 34 merely indicates that Grasso's system may include email services.

The examiner respectfully disagrees because the passage at paragraph 7 clearly states that Grasso's eCabinet "captures documents that have been printed, faxed, scanned or emailed and builds a digital archive of these documents".

For at least the above reason, it is submitted that Applicant's argument is not persuasive and the prior art of record reads on the claims.

18. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571)272-3964. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

December 21, 2005

*Alan J. Lin*  
12/21/05